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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/673,050	09/26/2003	Gardner G. Courson	250-0002US	8057

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EXAMINER

MOONEYHAM, JANICE A

ART UNIT	PAPER NUMBER
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3629

DATE MAILED: 03/22/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/673,050	Applicant(s) COURSON ET AL.	
	Examiner Janice A. Mooneyham	Art Unit 3629	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. This is in response to the applicant's communication filed on September 26, 2003, wherein claims 1-12 are currently pending.

Claim Objections

2. Claims 8-12 are objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. It is not clear whether claim 8 a proper dependent claim or not since the Examiner is unable to tell what claim 5 is actually directed to and thus is unable to make a final determination at this time.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 1-12 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

4. First, in claim 1, the applicant claims a discovery mechanism to combine discovery related information and form discovery materials to produce discovery items

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for use in litigation. The specification does not describe how to combine the information and form the discovery materials in such a way as to enable one skilled in the art to make or use the invention.

5. Claim 5 is directed to a tool for recommending a decision in litigation. A decision in litigation is generally rendered by a judge or a jury. Therefore, the specification does not disclose how the invention would recommend a decision in litigation.

6. Claim 5 discloses weighting values with each element and an analyzer using the stored information and the values to determine a resultant value and a recommendation element using the determined resultant value to an associated decision option to provide a recommended decision.

The applicant has identified an invention which requires a user to input information into a computer wherein many of the values are provided by the subjective analysis of the user. Because the values are subjective, for a single situation, there could be different results based on the subjective analysis and determination of each user. This subjective information would result in a different value depending on the individual users. Thus, for each individual performing the invention, the result would be different and would have a different meaning. Therefore, the invention does not produce a repeatable or concrete result as required by the statute. The users of the invention must conduct a great deal of experimentation on their part in order to use the invention – to the point that the users become the inventor of their own application of the invention rather than the applicant.

Thus, the claims contain subject matter which was not described in the specification in such a way as to enable one skilled in the art to use the invention since the subjective interpretation does not provide a concrete result which can be used by one in the industry other than the person actually entering the information.

7. Furthermore, claims 5-12 are also rejected under 35 U.S.C. 112, first paragraph since the claimed invention is not supported by either a specific asserted utility or a well established utility. For the reasons set forth above, one skilled in the art clearly would not know how to use the claimed invention. The applicant has not defined the numerical score used to assess the values entered. There is no defined meaning as to the value. It is unclear how one skilled in the art would know how the numerical score derived by the invention would be used or what the meaning of the score is to anyone other than what it means in the mind of the person actually entering the information. It is unclear how the numerical score value would be used by a person in the industry, i.e., what would the score mean to a person in the industry.

8. Claim 5 states that a recommendation element using the determined resultant value and the associated decision option provides a recommended decision. The specification does not describe how this recommended decision is made in such a way as to enable one skilled in the art to make or use the invention.

9. Claim 6 states that an analyzer and said recommendation element utilize said collected results to develop a resultant value or recommended decisions. The specification does not describe how to perform this step in such a way as to enable one skilled in the art to make or use the invention.

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10. Claim 8 states that an assessment is provided. The specification does not describe this assessment is provided in such a way as to enable one skilled in the art to make or use the invention.

11. Claims 9-12 identify a statistical decision tree. The specification does not describe how to develop the decision tree in such a way as to enable one skilled in the art to make or use the invention.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

12. Claims 1-12 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

13. It is not clear what statutory class the invention falls into. The applicant simply identifies the invention as a tool. However, there is no clear structure identified and there are no clear method steps.

14. What does the applicant mean by "a tool"?

15. What does the applicant mean by the following language in claim 1 – *an entry field available on a plurality of views not directly related to discovery to request collection of discovery request?*

16. What does the applicant identify as an analyzer?

17. Claim 8 identifies the invention as "a tool". However, the body of the claim language states that there are a plurality of tools according to claim 5. This is unclear.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

18. Claims 1-12 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Under the statute, the claimed invention must fall into one of the four recognized statutory classes of invention, namely, a process (or method); a machine (or system); an article of manufacture; or a composition of matter. It is not clear what the applicant what statutory class the applicant's invention would fall into. The applicant identifies the invention as a tool. There does not appear to be any structure identified. Thus, the invention is not clearly a machine or system. The applicant does not clearly define method steps although such language as set forth in claim 1 could be construed to be a method step (storage of discovery related information gathered from said menu). Therefore, the invention does not clearly fall into the statutory class of process or method. It is not an article of manufacture or a composition of matter. Therefore, the invention appears to be non-statutory.

19. Furthermore, it is not clear whether the tool is software or a web site or web pages. Claims drawn to web sites or web pages require careful analysis. It should be determined whether such a claim is drawn to a collection of files or to computer or network hardware.

According to common definitions and barring any "special definition" in an application, web sites or web pages are *files or documents*, not the computer or network

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hardware that makes available or presents these files. The MPEP gives us guidance on how to deal with files or documents at MPEP 2106 IV B 1 (a) and (b), under the headings of "functional descriptive material" and "nonfunctional descriptive material".

If the files or documents are data structures or computer executable code, they are statutory if they are embodied on a computer-readable medium, provided of course they provide a useful, concrete and tangible result. If the files or documents are nonfunctional descriptive material, e.g. music, photographs, compilations of data, such material cannot exhibit any functional interrelationship with the way in which computing processes are performed and would not be statutory. This is true even if the nonfunctional descriptive material is embodied on a computer-readable medium.

20. Claims 5-12 are rejected under 35 U.S.C. 101 because for a claimed invention to be statutory, the claimed invention must produce a useful, concrete, and tangible result. "Usefulness" may be evidenced by, but not limited to, a specific utility of the claimed invention. "Concreteness" may be evidenced by, but not limited to, repeatability and/or implementation without undue experimentation. "Tangibility" may be evidenced by, but not limited to, a real or actual effect

In the present case, the values are subjective. Furthermore, the decision tree identified in claims 9-12 is developed with input from experienced lawyers. Thus, because the values and input are subjective, for a single situation, there could be different results based on the subjective determination of the user. Therefore, the applicant's invention is not capable of providing concrete results as required by 35 U.S.C. 101 since it would be difficult for a person to repeat the analysis and

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determination of another based on the subjective subject matter without undue experimentation.

The Examiner finds that because claim(s) 1-12 are replete with 35 U.S.C. 112 2nd paragraph indefiniteness rejections, it is difficult if not impossible to completely construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO's policy of providing art rejections even though the claim(s) contain 35 U.S.C. 112 2nd paragraph rejections, the claims are construed and the art is applied *as much as practically possible*. As noted below, Applicant(s) are invited to contact the Examiner if additional assistance is needed.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Newell et al (US 2003/0112270) (hereinafter referred to as Newell).

Referring to Claim 1:

Newell discloses a tool for developing litigation discovery materials, comprising:

an entry field (Figure 1a (103), [0056];

a menu (Figure 3A);

storage ([0024-0029];

forms (Figure 3B-2 Common Case Forms);

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production mechanism [0100].

Referring to Claims 2-4:

Newell discloses the menu includes information relating to discovery type and party [0030-0031].

Referring to Claims 5-12:

Newell discloses a tool for aiding in litigation, comprising:

interfaces [Figure 1a (103)] ;

storage [0024-0029];

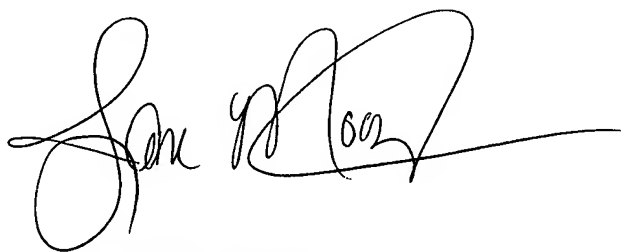
an analyzer (processor unit 112).

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Janice A. Mooneyham whose telephone number is (571) 272-6805. The examiner can normally be reached on Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on (571) 272-6812. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in black ink, appearing to read "Jan Mooneyham", with a long horizontal flourish extending to the right.

Jan Mooneyham
Patent Examiner
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